

FEE TRANSMITTAL for FY 2005

Effective 10/01/2003. Patent fees are subject to annual revision

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 250

Complete if Known

Application Number	10/027,010
Filing Date	12/21/2001
First Named Inventor	Gregory L. Renda
Examiner Name	Shah, Kamini
Art Unit	2142
Attorney Docket No.	1270

METHOD OF PAYMENT (check all that apply)

☐ Check ☒ Credit card ☐ Money Order ☐ Other ☐ None☐ Deposit Account:

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FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	1000	2001	500	Utility filing/search/exam	
1002	350	2002	175	Design filing/search/exam	
1003	550	2003	275	Plant filing/search/exam	
1004	790	2004	395	Reissue filing/search/exam	
1005	200	2005	100	Provisional filing fee	
SUBTOTAL (1)				(\$)	

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims		Extra Claims		Fee from below		Fee Paid	
Independent	26	- 26** =		X		=	
Multiple Dependent	4	- 4** =		X		=	

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	50	2202	25	Claims in excess of 20	
1201	200	2201	100	Independent claims in excess of 3	
1203	360	2203	180	Multiple dependent claim, if not paid	
1204	88	2204	44	**Reissue independent claims over original patent	
1205	18	2205	9	**Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)				(\$)	

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge-late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2520	1812	2520	For filing a request for ex parte reexamination	
1804	920	1804	920	Requesting publication of SIR prior to Examiner action	
1805	1840	1805	1840	Requesting publication of SIR after Examiner action	
1251	120	2251	60	Extension for reply within first month	
1252	450	2252	225	Extension for reply within second month	
1253	1020	2253	510	Extension for reply within third month	
1254	1590	2254	795	Extension for reply within fourth month	
1255	1890	2255	1080	Extension for reply within fifth month	
1401	500	2401	250	Notice of Appeal	
1402	500	2402	250	Filing a brief in support of an appeal	250
1403	1000	2403	500	Request for oral hearing	
1451	1510	1451	1510	Petition to institute a public use proceeding	
1452	500	2452	250	Petition to revive - unavoidable	
1453	1500	2453	750	Petition to revive - unintentional	
1501	1400	2501	700	Utility issue fee (or reissue)	
1502	800	2502	400	Design issue fee	
1503	1100	2503	550	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	790	2809	395	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR 1.129(b))	
1801	790	2801	395	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	
Other fee (specify)					
*Reduced by Basic Filing Fee Paid				SUBTOTAL (3)	(\$ 250

SUBMITTED BY

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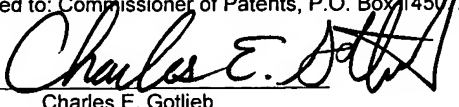
be included on this form. Provide credit card information and authorization on PTO-2038.

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Gregory L. Renda et. al.
SERIAL NO: 10/027,010
FILING DATE: 12/21/2001
TITLE: System and Method for Providing Access To A Network With Selective
Network Address Translation
GROUP ART UNIT: 2142
ATTY DOCKET NO: 1270
EXAMINER: Shah, Kamini

CERTIFICATION OF MAILING	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner of Patents, P.O. Box 1450 Alexandria, VA 22313 on the date shown below:	
Date: 5/8/2006	 Charles E. Gotlieb

05/15/2006 AKELECH1 00000003 10027010

01 FC:2401

250.00 OP

THE HONORABLE COMMISSIONER OF PATENTS, ALEXANDRIA, VA 22313

APPEAL BRIEF UNDER 37 C.F.R. 1.192

SIR:

In support of the appeal of the above-referenced case:

05/15/2006 AKELECH1 00000049 10027010

01 FC:2402

250.00 OP

1. Real Party in Interest.

The real party in interest is Vernier Networks, Inc.

2. Related Appeals and Interferences.

US Application serial number 10/027,011, described
5 below, is being concurrently appealed. In each case, the
other application is asserted under a double patenting
rejection.

3. Status of Claims.

All claims are rejected.

10 4. Status of Amendments.

Amendment A was filed and entered in the application.
Amendment B, filed in response to a final office action,
was not entered. Amendment C is being submitted
concurrently herewith to correct typographical errors so as
15 to place the case into better condition for appeal. Claims
1, 8, 15 and 22 are being appealed. The claims stand and
fall together.

5. Summary of Claimed Subject Matter.

Claim 1 recites, "A method of forwarding a
20 communication," (page 106, lines 5-7 and page 52 line 21-
page 53 line 9) "comprising:

"receiving for each of a plurality of users an indication having one selected from a first state and a second state;" (page 106, lines 11-15, page 111, line 22-
25 page 112, line 8)

"receiving the communication having a source identifier;" (page 106, lines 7-11)

"retrieving at least one of said indications;" (page 107, lines 18-22)

30 "responsive to the at least one indication retrieved having the first state, forwarding the communication with the source identifier received with the communication; and" (page 107, line 18 - page 108, line 1)

35 "responsive to the at least one indication retrieved having the second state, forwarding the communication with an alternate source identifier different from the source identifier received with the communication." (page 107 line 18 - page 108, line 6)

40 Claim 8 recites, "A system for forwarding a communication, comprising:"

"a privileges requestor having a privileges input operatively coupled for receiving for each of a plurality of users, an indication having one selected from a first state and a second state, the privileges requestor for

45 providing at an output at least one of the indications;"
(page 61 line 5-page 66 line 13)

"an access point manager having an input operatively
coupled for receiving the communication having at least one
selected from a source identifier and an alternate
50 identifier, the access point manager for building and
providing at an output a second communication responsive to
the first communication; and" (page 27 line 7-page 28 line
6)

"a network address translation manager having a
55 communication input coupled to the access point manager for
receiving at least a portion of the second communication,
and a privileges input coupled to the privileges requestor
output for receiving the at least one indications," (page
37 line 3-page 38 line 21) "the network address translation
60 manager for providing at an output a third communication
comprising:

"at least a portion of the source identifier,
responsive to at least one of the at least one indications
received at the privileges requestor input having the first
65 state; and" (page 40 lines 3-15)

"a third source identifier responsive to at least one
of the at least one indications received at the privileges

requestor input having the second state." (page 38 line 21-
page 39 line 17 and page 40 line 15-page 41 line 6)

70 Claim 15 recites, "A computer program product" (page
16 lines 9-14) "comprising a computer useable medium having
computer readable program code embodied therein" (page 16
lines 14-20) "for forwarding a communication," (page 106,
lines 5-7 and page 52 line 21-page 53 line 9) "comprising
75 computer readable program code devices configured to cause
a computer to:

 "receive for each of a plurality of users an
indication having one selected from a first state and a
second state;" (page 106, lines 11-15, page 111, line 22-
80 page 112, line 8)

 "receive the communication having a source
identifier;" (page 106, lines 7-11)

 "retrieve at least one of said indications;" (page
107, lines 18-22)

85 "responsive to the at least one indication retrieved
having the first state, forward the communication with the
source identifier received with the communication; and"
(page 107, line 18 - page 108, line 1)

 "responsive to the at least one indication retrieved
90 having the second state, forward the communication with an

alternate source identifier different from the source
identifier received with the communication." (page 107 line
18 - page 108, line 6)

Claim 22 recites, "An apparatus for forwarding a
95 communication," (page 27 line 7-page 28 line 6, page 40
lines 3-page 41 line 6, and page 52 line 21-page 53 line 5)
"comprising:

"means for receiving for each of a plurality of users
an indication having one selected from a first state and a
100 second state;" (page 61 line 5-page 66 line 13)

"means for receiving the communication having a source
identifier;" (page 27 line 7-page 28 line 6)

"means for retrieving at least one of said
indications; and" (page 37 line 3-page 38 line 21)

105 "means for:

"responsive to the at least one indication retrieved
having the first state, forwarding the communication with
the source identifier received with the communication; and"
(page 40 lines 3-15)

110 "responsive to the at least one indication retrieved
having the second state, forwarding the communication with
an alternate source identifier different from the source

identifier received with the communication." (page 38 line 21-page 39 line 17 and page 40 line 15-page 41 line 6)

115 6. Grounds of Rejection to be Reviewed on Appeal.

A. Examiner provisionally rejects claims 1, 8, 15 and 22 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 12, 23 and 34 of copending Application No. 10/027,011.

120 B. Examiner rejects claims 1-22 under 35 U.S.C. 112, first paragraph.

C. Examiner rejects claims 1, 8, 15, and 22 under 35 U.S.C. 112, second paragraph.

D. Examiner rejects claims 1-26 under 35 U.S.C. 102(e)
125 as being anticipated by Keeler, Jr. et al., US 6,502,130.

7. Argument.

A. The Claims Are Not Being Double Patented Because The Claims As A Whole Are Distinct, And Not Obvious Variations.

130 In the present application, claim 1 recites,
"responsive to the at least one indication retrieved having the first state, forwarding the communication with the source identifier received with the communication; and responsive to the at least one indication retrieved having

the second state, forwarding the communication with an alternate source identifier different from the source identifier received with the communication".

In copending Application No. 10/027,011, Claim 1
5 recites, "selectively granting access to a network to a communication received from a device having the device identifier received, responsive to the at least one set of privileges received".

Examiner argues that the claimed language in the
10 present application "responsive to the at least one indication retrieved having the first state" is equivalent to the claimed language in the other application "responsive to the at least one set of privileges received", and that the language in the present application
15 "forwarding the communication with an alternate source identifier different from the source identifier received with the communication" is equivalent to the language "selectively granting access to a network to a communication received from a device having the device
20 identifier received". Examiner also argues that claims in the present application claiming more than one state such as first and second, is obvious and provides similar function as to the sets of privileges.

"Obviousness-type double patenting is a judicially created doctrine intended to prevent *improper* timewise extension of the patent right by prohibiting the issuance of claims in a second patent which are not 'patentably distinct' from the claims of a first patent...The doctrine has also been phrased as prohibiting claims in the second patent which define 'merely an obvious variation' of an invention claimed in the first patent." In re Braat, 937 F.2d 589, 592 19 USPq2d 1289, 1291-92 (Fed. Cir. 1991).

1. The Claims Are Not Being Double Patented Because the Claims as a Whole Are Distinct.

Examiner is required to show that the claims of the present application are not patentably distinct or are merely an obvious variation over the claims of the copending application. Instead, Examiner focuses merely on one element in the claims while ignoring the essential distinction between the two. Even granting for the sake of argument that Examiner is correct that claiming more than one state such as a first and second provides similar function as the sets of privileges, Examiner provides no basis for equating the language "forwarding the communication with an alternate source identifier" with the language "selectively granting access to a network to a

communication received". These are two very different functions.

In the case of the present application, the communication is forwarded regardless of the state of the
5 at least one indication. However, the communication may be forwarded with its original source identifier or with an alternate identifier depending on a state of at least one indication retrieved. By contrast, in the other application, access to the network is *selectively granted*,
10 not always granted. Thus, the present application forwards a communication with a source identifier that may or may not differ from the original source identifier. The other application might not forward the communication at all.

Examiner's focus on one potential element of
15 similarity between the claims does not meet the standard of an obviousness-type rejection. It is the claim as a whole that should be investigated. The claims as a whole are distinct as described below.

2. The Claims Are Not Being Double Patented Because
20 the Claims Are Not Obvious Variations.

"Forwarding the communication with an alternate source identifier" is distinct from "selectively granting access to a network to a communication received" because in the

first case the communication is always forwarded, whereas
in the second case the communication is selectively granted
access to the network. The issue of selectively granting
access to a network is distinct from the issue of changing
5 or not changing the source identifier of a communication,
and both are non-trivial issues in computer networking.

It would not be obvious to change selectively granting
access to a network to always granting access with
different source identifiers. These two techniques address
10 separate and different problems. Therefore, claim 1 of the
present application is patentably distinct from claim 1 of
the copending application and not merely an obvious
variation. Claims 8, 15, and 22 recite at least similar
features and are patentably distinct and not merely an
15 obvious variation from the copending application for the
same reason.

Therefore, the obviousness-type double patenting
rejection should be reversed.

B. The Specification Provides Enablement Because One
20 Example of Each Claim Element Is Disclosed in the
Specification, And Undue Experimentation Is Not Required.

Claim 1 recites, "responsive to the at least one
indication retrieved having the first state, forwarding the

communication with the source identifier received with the
communication; and responsive to the at least one
indication retrieved having the second state, forwarding
the communication with an alternate source identifier
5 different from the source identifier received with the
communication".

Examiner argues that the specification, while being
enabling for network access points and privileges of a
class, does not reasonably provide enablement for a first
10 state and a second state. Examiner argues that real IP
mode is recited in the specification but not clearly
defined as the first state, and that defining the second
state as "otherwise" is indefinite and an undue experiment
to perform a second state which is not clearly defined in
15 the specification.

"The subject matter of the claim need not be described
literally (i.e., using the same terms or in haec verba) in
order for the disclosure to satisfy the description
requirement." (MPEP 2163.02)

20 1. The Specification Provides Enablement Because One
Example of Each Claim Element Is Disclosed in the
Specification.

The specification states at several points that a device may operate either in real IP mode or not in such a mode. For example, the at page 107 line 18-page 108, line 5: "if the device sending the frame in step **310 has real IP mode active** (e.g. has privileges, and any conditions apply and has an IP address appropriate for the subnetwork as described above) **327**, a frame corresponding to the frame received in step **310** is sent **329**. **Otherwise 327**, the translated IP address and port are retrieved from the table **328** and used to translate the source IP address and port of the frame as described above and the resulting frame is sent in the direction of the network and deleted from local storage **330**." (Emphasis is in bold italics added.) This sentence shows that the privileges for users contain an indication that has one selected from a first state (real IP mode active) and a second state (otherwise). Page 21, lines 6-8 and page 26, lines 3-14 state show that there are privileges records for each of a plurality of users as claimed. Page 24 line 21-page 25 line 14 give a concise description of real IP mode and its effects. The descriptions of the areas of the specification in which the claims are supported are not intended to be exhaustive, as there may be additional support in the specification for the claim language.

A first state (real IP mode) and a second state (otherwise) are clearly described in the specification. The claim language does not refer to these particular states by name but uses broader language, as is permissible under the case law set forth above. It isn't necessary for the language of the specification to match the language of the claim. All that is necessary is that one example of each claim element is disclosed in the specification. An example of the claim element "the at least one indication retrieved having the first state" is provided by the specification in the form of real IP mode being active, and an example of the claim element "the at least one indication retrieved having the second state" is provided by the specification in the form of real IP mode not being active (e.g. otherwise). Therefore, the disclosure satisfies the description requirement and Examiner's 35 U.S.C. 112 rejection is improper.

2. The Specification Does Not Require Undue Experimentation.

"[A]n extended period of experimentation may not be undue if the skilled artisan is given sufficient direction or guidance." In re Colianni, 561 F.2d 220, 224, 195 USPQ 150, 153 (CCPA 1977).

Examiner argues that defining the first state as real IP mode and the second state as "otherwise" amounts to a requirement of undue experimentation to reproduce the second state. On the contrary, this state, i.e. the state of not being in real IP mode, is clearly defined in the specification, for example on page 25 lines 4-11: "when real IP mode is not enabled or not enabled under the conditions in which the communication is being sent, communications from a user are translated using conventional network address translation techniques and the IP address and the network address of the device **242-256** being used by the user is not sent in the direction of the network **214** by access controller **220**." It is also described by the specification at page 107, line 18 - page 108 line 5 as described above. Therefore, it requires no experimentation at all to reproduce the state of not being in real IP mode. It does not require experimentation merely because one condition (real IP mode being active) is stated with one result and all remaining conditions are stated as "otherwise". These are two states: real IP mode being active and real IP mode not being active. Since one embodiment of a first state and a second state is set forth in the specification, the specification is enabling for claims 1, 8, 15 and 22.

Therefore, the 112, first paragraph rejection should be reversed.

C. The Claims Are Not Indefinite Because The Subject Matter Which Applicant Regards as the Invention Is
5 Distinctly Pointed Out And Claimed.

Claim 1 recites "receiving for each of a plurality of users an indication having one selected from a first state and a second state".

Examiner argues it is unclear whether both the first
10 and second states are received or either one.

"Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a
15 Markush group, recites members as being "selected from the group consisting of A, B and C." See Ex parte Markush, 1925 C.D. 126 (Comm'r Pat. 1925)."

Claim 1 recites, "an indication having one selected from a first state and a second state" (emphasis added).
20 This language is a Markush group and means the indication has only one state, a first state or a second state, but not both. This language has been in the claim all along. Therefore, Claim 1 particularly points out and distinctly

claims the subject matter which Applicant regards as the invention, and Examiner's rejection is improper. Claims 8, 15, and 22 recite at least similar language and are patentable for the same reason.

5 Therefore, the 112, second paragraph rejection should be reversed.

D. The Claims Are Not Anticipated By Keeler, Jr. Et Al Because Keeler Does Not Show the Claim Features of Different Source Identifiers Sent with the Communication
10 Responsive to a State of an Indication.

 Claim 1 recites, "responsive to the at least one indication retrieved having the first state, forwarding the communication with the source identifier received with the communication; and responsive to the indication retrieved
15 having the second state, forwarding the communication with an alternate source identifier different from the source identifier received with the communication".

 Claim 8 recites, a "network address translation manager for providing at an output a third communication
20 comprising: at least a portion of the source identifier, responsive to at least one of the at least one indications received at the privileges requestor input having the first state; and a third source identifier responsive to at least

one of the at least one indications received at the
privileges requestor input having the second state".

Claim 15 recites, "responsive to the at least one
indication retrieved having the first state, forward the
5 communication with the source identifier received with the
communication; and responsive to the at least one
indication retrieved having the second state, forward the
communication with an alternate source identifier different
from the source identifier received with the
10 communication".

Claim 22 recites, "responsive to the at least one
indication retrieved having the first state, forwarding the
communication with the source identifier received with the
communication; and responsive to the at least one
15 indication retrieved having the second state, forwarding
the communication with an alternate source identifier
different from the source identifier received with the
communication".

"To establish prima facie obviousness of a claimed
20 invention, all the claim limitations must be taught or
suggested by the prior art. In re Royka, 490 F.2d 981, 180
USPQ 580 (CCPA 1974)." "To establish inherency, the
extrinsic evidence 'must make clear that the missing

descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

The claims rejected by Examiner provide a communication with one source identifier if the indication has a first state, or a different source identifier if the indication has a second state. The use of the term "and" in the claim language should not be meant to imply that both source identifiers must be supplied, as one or the other may be supplied under the claims because although both statements apply, only one will be applicable because the indication will either have the first state or the second state as is described in the claims. For this reason, Examiner's interpretation of the claim language is incorrect.

These claimed features are not shown by Keeler. Keeler addresses an XID that appears to be used instead of the MAC address of a device if the device has permission to

communicate over the SNA network, and Keeler discloses that the routine sends the information to a log and collects the MAC ID and TCP/IP address. However, Keeler does not allow the communication to be forwarded with an alternate source
5 identifier if an indication is in a second state, for example, the device does not have permission to communicate over the SNA network. In that case, the communication does not appear to be forwarded at all.

There is nothing in Keeler that states that 1) there
10 are different source identifiers sent 2) with the communication 3) responsive to a state of an indication as claimed. Examiner argues that Keeler teaches forwarding a communication, but even if this were correct it would not be grounds for rejection, because Keeler does not teach
15 forwarding a communication with an alternate source identifier if an indication is in a second state.

Moreover, forwarding a communication with an alternate source identifier if an indication is in a second state is not inherently a part of Keeler because other options, such
20 as not forwarding the communication at all, are possible.

Because Keeler does not teach, expressly or inherently, forwarding a communication with an alternate source identifier if an indication is in a second state,

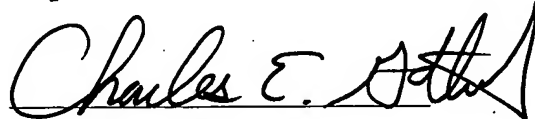
all of the claim limitations are not taught by the prior art as required, and the appealed claims are patentably distinguishable over the cited references. Therefore, the 102(e) rejection should be reversed.

5 Conclusion

Claims 1, 8, 15 and 22 are supported, enabled, definite, and patentably distinguishable over the cited references. Favorable action is solicited.

Respectfully Submitted

May 8, 2006



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8. Claims Appendix.

1. a method of forwarding a communication, comprising:

receiving for each of a plurality of users an indication having one selected from a first state and a second state;

receiving the communication having a source identifier;

retrieving at least one of said indications;

responsive to the at least one indication retrieved having the first state, forwarding the communication with the source identifier received with the communication; and

responsive to the at least one indication retrieved having the second state, forwarding the communication with an alternate source identifier different from the source identifier received with the communication.

8. A system for forwarding a communication, comprising:

a privileges requestor having a privileges input operatively coupled for receiving for each of a plurality of users, an indication having one selected from a first

state and a second state, the privileges requestor for providing at an output at least one of the indications;

an access point manager having an input operatively coupled for receiving the communication having at least one selected from a source identifier and an alternate identifier, the access point manager for building and providing at an output a second communication responsive to the first communication; and

a network address translation manager having a communication input coupled to the access point manager for receiving at least a portion of the second communication, and a privileges input coupled to the privileges requestor output for receiving the at least one indications, the network address translation manager for providing at an output a third communication comprising:

at least a portion of the source identifier, responsive to at least one of the at least one indications received at the privileges requestor input having the first state; and

a third source identifier responsive to at least one of the at least one indications received at the privileges requestor input having the second state.

15. A computer program product comprising a computer useable medium having computer readable program code embodied therein for forwarding a communication, comprising computer readable program code devices configured to cause a computer to:

receive for each of a plurality of users an indication having one selected from a first state and a second state;

receive the communication having a source identifier;

retrieve at least one of said indications;

responsive to the at least one indication retrieved having the first state, forward the communication with the source identifier received with the communication; and

responsive to the at least one indication retrieved having the second state, forward the communication with an alternate source identifier different from the source identifier received with the communication.

22. An apparatus for forwarding a communication, comprising:

means for receiving for each of a plurality of users an indication having one selected from a first state and a second state;

means for receiving the communication having a source identifier;

means for retrieving at least one of said indications;
and

means for:

responsive to the at least one indication retrieved having the first state, forwarding the communication with the source identifier received with the communication; and

responsive to the at least one indication retrieved having the second state, forwarding the communication with an alternate source identifier different from the source identifier received with the communication.



9. Evidence Appendix.

No evidence appendix is being submitted.